

*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
Page 8 of 20

### **Remarks/Arguments**

Applicant respectfully requests consideration of this amendment and the remarks/comments presented herein. Applicant further asserts the finality of the October 24, 2005 office action should be withdrawn as premature.

#### **The October 24, 2005 Office Action Should Not Be “Final”**

The examination of this application has been drawn out considerably. After filing an appeal brief, the primary examiner agreed upon claim language and applicant withdrew the appeal and filed an RCE. The agreed claim language was rejected by Examiner Truong in the July 12, 2005 Office Action. In an attempt to move the process forward, applicant conducted a personal interview with Examiner Truong on August 23, 2005. At the interview, an agreement as to claim language was tentatively reached. Applicant's representatives at the interview were prepared to submit a declaration of commercial success pursuant to 37 C.F.R. § 1.32, but declined to present such evidence upon reaching an agreement as to allowable claim language.

After the interview, an informal amendment was presented to Examiner Truong which she indicated should traverse all rejections. The informal amendment was formalized and filed on August 31, 2005. Subsequently, Examiner Truong indicated a few minor changes for correcting the form of the

*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
Page 9 of 20

claims. Accordingly, applicant filed a formal supplementary amendment with these suggested changes on September 30, 2005.

In the September 30, 2005 supplementary amendment, applicant traversed all rejections in the July 12, 2005 office action, as indicated by the withdrawal of the references, however all claims were rejected based on completely new references which were not of record prior to the October 24, 2005 Office Action.

Applicant's amendments in the August 31, 2005 amendment and the September 30, 2005 supplementary amendment were made with approval by Examiner Truong after discussing the issue with her. Applicant's amendments did not add new elements not already present in the claims, but only utilized existing elements differently to clearly demonstrate the differences between applicant's invention and the prior art of record at the time. Applicant's amendments did not necessitate the new grounds of rejection.

Furthermore, applicant relied on Examiner Truong's assertions that the art of record would be traversed with the amendments and chose not to submit its evidence of commercial success because the evidence seemed unnecessary. The evidence seemed unnecessary due to Examiner Truong's indication that all references had been traversed.

The October 24, 2005 office action cites five new references never made of record in this application and rejects all claims. The October 24, 2005 office

*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
Page 10 of 20

action was prematurely made a final rejection. While performing an updated search based on claim amendments and citing new references in rejecting claims can be proper, , it is improper to finalize a rejection based on five new references completely unknown to the applicant prior to the October 24, 2005 office action where the claims did not add new elements that had not been searched in prior searches. The office action cites no references for which applicant had notice in forming the new grounds of rejection. Applicant's amendments did not necessitate the new grounds of rejection and applicant did not submit evidence of non-obviousness due to reliance on statements made by Examiner Truong.

Because the October 24, 2005 office action should not have been made final, applicant respectfully requests withdrawal of the finality of the rejection, entry of the current amendment, and consideration of applicant's remarks and arguments including the evidence of commercial success presented herewith.

### **35 U.S.C. § 112 Rejections**

Claims 25 and 28 were rejected as being indefinite for improperly using the Markush style to claim alternative limitations. Applicant appreciates the examiner noticing the improper use of the Markush style claims. Accordingly, applicant amended claims 25 and 28 to be in proper Markush form. Applicant respectfully requests reconsideration of claims 25 and 28 as amended and allowance of these claims in view of the remarks/arguments presented herein.

*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
Page 11 of 20

### **35 U.S.C. § 103 Rejections**

The October 24, 2005 office action relies on U.S. Patent 6,182,131 to Dean et al. in combination with U.S. Patent 6,175,831 to Weinreich et al. to form a rejection of independent claims 1, 17, and 24 under 35 U.S.C. § 103(a). These references cannot be combined to form an obviousness rejection because they teach away from each other and the present invention. Furthermore, if the references are combined, they fail to teach all limitations of the invention as claimed in at least independent claims 1, 17, and 24.

#### Background

Dean discloses a method for automatically creating user accounts with identical user names on a separate network based on the user names and other information on a current network. Dean's invention inherently requires multiple databases because the user names are transferred from the user database on one network to the user database on another network. 1/34-43 (column/line). Dean does not disclose this database being made available on the internet as a web-based database. Dean does not disclose or suggest a method to utilize the invention by the users themselves to modify any of their account information.

Weinreich discloses a single database wherein the database is constructed by issuing an email from a database provider to a first individual. 2/54-56 (column/line). The first individual is then invited to provide selected information

*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
Page 12 of 20

via return email. The selected information includes at least a name and email address of a second individual such that the system can send an email to the second individual inviting that individual to provide selected information via email. 2/56-60. This process continues and the growth of the database can become exponential as more members sign up additional members. 3/64-67. The system thus stores the records of many members who each signed up voluntarily so that the members can establish a network of contacts.

In contrast to both Weinreich and Dean, claim 1 of applicant's invention requires an existing database transfer records to a web-based database automatically and without express registration action in the web-based database. The multiple records are then populated within the web-based database such that access accounts can be created for the multiple individuals without the individuals performing an express registration action in the web-based database. The claimed invention then discloses transmitting at least one access account to at least one of the individuals such that the individual can remotely maintain the individual records. Claim 17 is the system analog of method claim 1. Claim 24 is similar to claim 1 but also limiting the express registration action in the web-based database to customers, and not to anyone as in claim 1. Accordingly, claim 1 will be discussed in detail as representative of the broadest claim and only the applicable differences in claims 17 and 24 will be discussed.

*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
Page 13 of 20

Dean teaches away from the claimed invention.

Dean's disclosure is inherently opposed to the applicant's claimed invention. The office action readily admits that Dean fails to disclose or teach "a web-based database; maintaining and updating a web-based database; transmitting at least one access account to at least one of the multiple individuals; enabling remote maintenance of the individual records by the individuals by use of the access account." These limitations are missing from Dean's disclosure because these limitations are not compatible with Dean's invention. Dean's disclosure does not suggest a need or desire to utilize a web-based database. Dean's invention is directed to creating new user accounts on a new network from user accounts on an existing network without having to type the user information in a second time. There is no disclosure or suggestion in Dean that the new user accounts are transmitted (or broadcast in the case of claims 17 and 24) to the users once the account is created on the new network. Dean discloses the purpose of the invention is to keep the user names and passwords the same for both the existing network and the new network. 3/46-52 (Column/line). If the user name and password are the same, there is no need or desire to transmit the new account information to the user. Additionally, Dean only requires the user name be extracted from the existing network, thus making communication of the access account on the new network impossible without more information. 3/20-21.

*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
 Page 14 of 20

If applicant's invention only transferred a name from the existing database to the web-based database, applicant's invention would not be suitable for its intended purpose. At a minimum, applicant's invention requires the claimed "record" includes some form of contact information in addition to the name. Without this contact information, the claimed "transmitting..." step could not occur.

Furthermore, Dean discloses only the creation of the new accounts but makes no suggestion that the new user accounts are to be utilized for remote maintenance (or modification as used in claim 24). For at least these reasons, Dean teaches away from the claimed invention and cannot be used to support an obviousness rejection.

Dean teaches away from Weinreich

Even if Dean does not teach away from applicant's claimed invention, Dean teaches away from Weinreich, thus making the combination of Dean and Weinreich improper to support an obviousness rejection. As discussed above, Dean's invention is directed to multiple databases and would not function without the transfer of account information from one database (network) to another database (network). In contrast, Weinreich discloses the use of a single database and offers no suggestion of utilizing multiple databases. Weinreich discloses the database may grow exponentially but fails to suggest that more than a single

*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
Page 15 of 20

database be utilized. 3/64-67 (column/line). Weinreich's single database is important because the purpose behind Weinreich's invention is to create relationships between its users where a first user can be linked to another user through intermediary links. 4/5-25. If Weinreich's system utilized multiple databases as required by both Dean and applicant's invention, the relationships would be difficult to maintain and it would render Weinreich's invention unsuitable for its intended purpose.

Weinreich teaches away from Dean

Weinreich teaches away from Dean because the teachings of Weinreich are incompatible with Dean. Dean's registration procedure is performed by a system administrator who automatically transfers account information from one network to another network without involving the end user. Weinreich's entire database construction is dependent on a first user providing information about a second user via manual entry and the second user signing up for an account and continuing this process. 3/52 – 4/4. Without the end user involvement, Weinreich's database would never be constructed and the invention would not be suitable for its intended purpose. It is not proper to combine one invention involving multiple databases that are replicated by a systems administrator (Dean) with an invention directed to the creation of a single exponentially sized database created by end users manually



*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
Page 16 of 20

responding to emails (Weinreich). These two concepts are not compatible and thus teach away from each other.

Weinreich teaches away from the claimed invention.

Weinreich also teaches away from the claimed invention as claimed in at least claims 1, 17, and 24. Specifically, Weinreich utilizes a single database that is designed to maintain complex relationships and grow exponentially. 3/62 – 4/20 (column/line). Weinreich discloses this single database and that all changes are made directly within the database. This creates potential security and maintenance issues which are inherently solved by Applicant's claimed invention. Applicant's claimed invention requires an existing database and a web-based database. Applicant's claimed invention requires that records be transferred from the existing database to the web-based database. One purpose of this transfer is to prevent individuals (claim 1) or customers (claims 17 and 24) from directly maintaining (claim 1) or modifying (claim 24) records directly in the existing database. This simplifies the management required of the database manager for the existing database by maintaining integrity in the existing database. This also inherently allows the database manager to review or reject changes in the web-based database before the changes are transferred back to the existing database.

Weinreich also teaches away from applicant's claimed invention by disclosing the use of a database created by the users. Weinreich teaches the

*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
Page 17 of 20

method of constructing the database begins by the database provider issuing an email to a first individual and that the first individual responds by registering and provides information of a second individual and the chain continues to automatically construct a single database. 2/54 – 3/32 (column/line). Without user registration in the database, Weinreich's database will never exist. In contrast, applicant's claimed invention utilizes an existing database and a web-based database. The web-based database is populated automatically and without express registration action in the web-based database. This limitation is required by all independent claims and is directly opposed to Weinreich's teachings where the users create the database. Applicant's invention would be useless for its intended purpose if the users created the web-based database as required by Weinreich.

Furthermore, Weinreich requires each user to register and does not even suggest saving their record in the database until after they register. Weinreich teaches "[t]he database service provider scans the incoming e-mail from the first individual, extracts from the e-mail message the information concerning the second individual, and then generates and transmits to the second individual an e-mail message inviting the second individual to join the database." 2/65–3/3 (column/line). This demonstrates that the second individual does not become a member of the database and have his or her record stored in the database until a registration action occurs. Applicant's invention in claims 1, 17, and 24 requires

*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
Page 18 of 20

the individual's record become a part of the web-based database "automatically and without express registration action in the web-based database." Accordingly, Weinreich teaches away from the claimed invention and cannot be utilized alone or in combination with other references to form the basis of an obviousness rejection.

#### Other Obviousness Considerations

Even if Weinreich and Dean do not teach away from each other, the office action provides no showing that there is any suggestion or motivation to combine the references. While both references are directed to databases, the databases serve very different functions and are not compatible with each other as described herein. Dean is directed toward a multiple database system where the second and subsequent databases are created by system administrators while Weinreich is directed to a single database created only when a user registers after receiving an email. The office action makes no finding that these references provide any suggestion or motivation to combine them. Without this showing, the office action fails to present a prima facie case supporting an obviousness rejection.

#### Evidence of Non-Obviousness

Applicant hereby presents evidence of commercial success to overcome the obviousness rejection. The evidence consists of two letters from major clients who purchased software based on the claimed invention and a declaration by the first named inventor pursuant to 37 C.F.R. § 1.132. The evidence demonstrates the

*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
Page 19 of 20

commercial success of the claimed invention and also demonstrates that the commercial success flows from the functions and advantages of the disclosed or inherent in the specification and claimed in at least claims 1, 17, and 24. The declaration negates any possibility that the commercial success is based on heavy advertising.

Additionally, the letters from Coca-Cola Enterprises and Marathon Oil demonstrate that the claimed invention's commercial success is based on the features and advantages of the claimed invention. The letters also suggest there was a long-felt need for the invention prior to AECSoft USA, Inc. introducing the products to the marketplace. The declaration and letters taken together indicate the commercial success of products embodying the claimed invention and that the product meets a long-felt need in the industry. This taken alone or in combination with the arguments presented herein demonstrates that applicant's claimed invention is not obvious.

## **Conclusion**

Claims 2-12 are dependent from claim 1 and is allowable for at least the reasons presented herein regarding claim 1. Claim 17 is allowable for at least the reasons presented herein regarding claim 1. Claims 18-23 are dependent from claim 17 and are allowable as being dependent from an allowable claim. Claim 24 is allowable for the reasons discussed herein regarding claims 1 and 17. Claims

*Supplementary Amendment Dated September 30, 2005*  
*U.S. Ser. No. 10/249,205*  
Page 20 of 20

25-28 are dependent from claim 24 and are thus allowable as being dependent from an allowable claim.

Applicant respectfully requests withdrawal of the finality of the October 24, 2005 office action as being premature, entry of the above amendment, and allowance of all claims. Please contact Jason Christiansen or David Dickinson at 713-652-2555 if you would like to discuss this matter further.

Respectfully submitted,



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